



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,233	09/10/2003	John M. Keating	P-1616-031	7718

7590 03/30/2006

Floyd E. Ivey
Liebler, Ivey, Connor & Berry
P.O. Box 6125
Kennewick, WA 99336

EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/660,233

Applicant(s)

KEATING, JOHN M.

Examiner

Stephen L. Blau

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5 and 7-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5 and 7-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 3/22/06
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5, 7-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "may" in line 8 in claim 11 is indefinite in that it is uncertain whether the limitation being referred to is required or not. Claim 13 is indefinite in that in lines 4-5 it is uncertain what the statement "the clip first end dimension D1 being less than the grip clip second end dimension D2 and the golf putter grip dimension D4, proximal the proximal the apparatus first end (20), being greater than the grip clip second end dimension D2" means. The part "the golf putter grip dimension D4, proximal the proximal the apparatus first end (20)," makes no sense to the examiner. The golf putter grip is not proximal (near) the apparatus first end (20) but far away. It seems like the section of "proximal the proximal the apparatus first end (20)", could be removed to correct this. Claim 14 is indefinite in that the statement "the apparatus at the clip slot will receive either the apparatus shaft to slide up the apparatus shaft toward the apparatus first end" is indefinite. How can the apparatus shaft (10) be moved up towards the apparatus first end (20) because the first end is on the shaft? The examiner can see how the apparatus at the clip slot will receive the putter shaft (72)

Art Unit: 3711

to slide the putter shaft (72) toward the first end (80) of the putter shaft and be affixed at a golf putter grip (75). Claim 14 is indefinite in that throughout the claim it appears that the putter shaft is being referred to as reference number 10 which is the apparatus shaft. Claim 8 is indefinite in that it states that the upper shaft has adequate length to contact the side of the player's neck and also there is a counter weight proximal the upper shaft first end (20). In figure 2 at the upper end (20) it is uncertain what is the shaft (10), the counter weight (22) and what is the black colored item at the upper end (20). If the black colored end is a grip or a counterweight than the upper shaft (10) is not touching the player's neck. In claim 10 reference number 42 has been called both the tubular means and the hinge means.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 5, and 7-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 8 requires a counter weight proximal the upper shaft end (20) and the upper shaft (10) having adequate length to contact the side of the player's neck. The specification and drawings are not enabling one skilled in the art to make or use the same. The specification does not differentiate what and where is the counter weight at

Art Unit: 3711

the end (20). If it is the black colored item in figure 2 than it is uncertain how the apparatus upper shaft (10) touches a player's neck because in figure 1 the black item is touching the player's neck. The part of the shaft which reference number 10 refers to is called the apparatus upper shaft (10) and it is not black.

Specification

5. The specification is objected under 37 C.F.R. rule 1.71 as being not written in a clear way to enable one skilled in the art to make and use the same. More specifically due to the changes to claim 8 it is uncertain how the upper shaft (10) touches a player's neck. The white part in figure 2 is called the apparatus upper shaft (10) yet in figure 1 it does not show the white part (10) touching the player's neck. It shows the black part touching the player's neck. It is uncertain what the counter weight is, the black part at the upper end (20) in figures 1 and 2 are, and what is actually touching the golfer's neck in figure 1.

Drawings

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the counter weight in claim 8 must be shown or the feature(s) canceled from the claim(s). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to

avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because:

a. Reference character "22" has been used to designate both the counter weight (page 4 line 1) and golfer's shoulder (page 6 line 12).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet

Art Unit: 3711

submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foresi in view of Bae.

Foresi discloses a putter apparatus having an upper shaft (30) with a counter weight in the form of a grip (33) proximal to an end (Fig. 5), a grip clip means in the form of a clamp affixed with a hinge means at an apparatus upper shaft second end (Fig. 6), and a apparatus upper shaft having adequate length such that the upper grip is able to contact the side of a player's neck (Fig. 3, 5, and 6).

Foresi lacks an upper shaft having adequate length to contact a side of a player's neck and a counter weight proximal an upper shaft first end.

Bae discloses a grip in the form of grip nodules spatially attached about a shaft in order to minimize weight (Abstract). In view of Bae it would have been obvious to modify the putter of Foresi to have a grip being nodules spatially attached about a shaft in order to minimize the weight of the grip material and thus the putter. As such a golfer would be able to contact a neck of the player to the shaft due to the grip not completely surrounding the end of the shaft. In addition, the grip nodule will have weight and are able to be considered a counter weight proximal an apparatus upper shaft first end.

10. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foresi in view of Bae as applied to claims 8-9 above, and further in view of Official Notice and Smith.

Foresi discloses an apparatus upper shaft being tubular (Col. 4, Lns. 22-30), a clip having a tubular member means, hinge means intermediate the ends of a clip (Fig. 6) and an end (68, fig. 6).

Foresi lacks a securing nut, a putter lower shaft, a putter grip and an apparatus upper shaft with a variety of cross-sections, a hinge leaves of plastic or metal, an upper shaft, putter lower shaft formed of plastics, composites or metals.

The examiner takes Official Notice that it is well known in the art to make shaft segments of a golf club varying in cross-section in order to form a tapered shaft which minimizes the total weight of a golf club. In view of the Examiner's Official Notice it would have been obvious to form a putter lower shaft, a putter grip and an apparatus

Art Unit: 3711

upper shaft with a variety of cross-sections in order to have tapered shafts and thus minimize the total width of a club.

The examiner takes Official Notice that it is well known in the art to make hinge affixing means of leaves using plastics or metals as well as making shaft members of a golf club out of plastics, composites or metals. In view of the Examiner's Official Notice it would have been obvious to form hinge affixing means of leaves using plastics or metals and shaft members of a golf club out of plastics, composites or metals in order to form rigid members which are able to withstand the stresses placed on a golf club during putting of a ball.

Smith discloses a secondary shaft which is connected to a club shaft having a hinge with a bolt (Fig. 2, Ref. f). In view of the patent of Smith it would have been obvious to modify the putter of Foresi to have a hinge means with a bolt in order to tighten the leafs of the hinge together.

11. Claims 5, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foresi in view of Bae, Official Notice and Smith as applied to claims 10-11 above, and further in view of Tucker and Cline.

Foresi discloses an apparatus which has a clamp with has a slot for affixing to a putter shaft (Fig. 8).

Foresi lacks a slot dimension being greater than the putter shaft dimension near the head, a slot dimension be less than the putter grip dimension, and a clip tapering from one end to the other.

Tucker discloses a clamp/clip with a slot where the slot dimension is greater than the putter shaft dimension near the head and the slot dimension be less than the putter grip dimension in order to fit the clamp on at the small diameter end of a shaft (Col. 2, Lns. 55-60). In view of the patent of Tucker it would have been obvious to modify the apparatus of Foresi to have a slot dimension being greater than the putter shaft dimension near the head and a slot dimension be less than the putter grip dimension in order to allow fitting the clamp on at a small diameter end of a shaft yet prevent the apparatus from inadvertently slipping off the butt end of the grip.

Cline discloses a clamp/clip for a shaft tapering from one end to the other in order to have a snug fit with a shaft which is tapered (Col. 3, Lns. 41-55). In view of the patent of Cline it would have been obvious to modify the clamp of Foresi to have a clip tapering from one end to the other in order to have a snug fit with a shaft and grip with is tapering.

12. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foresi in view of Bae, Official Notice, Smith, Tucker and Cline as applied to claims 5, and 12-14 above, and further in view of Sosin.

Foresi lacks a method of putting which includes steps of positioning the upper shaft end in contact with a golfer's neck and a step of executing and a putting stroke by retaining the upper shaft first end in contact with the golfer's neck throughout the putting stroke.

Sosin discloses a method of putting which includes steps of positioning the upper shaft end in contact with a golfer's neck and a step of executing and a putting stroke by retaining the upper shaft first end in contact with the golfer's neck throughout the putting stroke (Figs. 6C-6E) in order to help stabilize the putt (Abstract). In view of the patent of Sosin it would have been obvious to modify the method of putting of Foresi to have a step of steps of positioning the upper shaft end in contact with a golfer's neck and a step of executing and a putting stroke by retaining the upper shaft first end in contact with the golfer's neck throughout the putting stroke in order to help stabilize the putt.

Response to Arguments

13. Applicant's arguments with respect to claim 8 for Smith or Schuster have been considered but are moot in view of the new ground(s) of rejection. The argument that the reference of Foresi is improper due to the applicant not disclosing or depicting or claiming a bend and Foresi has a bend is disagreed with. The claims do not prevent an apparatus upper shaft from being bent. Nothing in the claims requires the upper shaft to be completely straight. The argument that the reference of Foresi is improper for claim 8 due to the added structure of the upper shaft having adequate length to contact a side of a player's neck is disagreed with. Claim 8 is an apparatus claim. Weight is given to what an apparatus is and not how it is intended to be used. Clearly Foresi has an upper shaft length which is long enough that a golfer's is able to touch the end of the upper shaft with the neck of the golfer. The argument that the reference of Sosin is

Art Unit: 3711

improper to use in the rejection due to nothing in the reference of Sosin mentions a neck is disagreed with. Sosin mentions a shoulder. But clearly in the figures (6C-6E) the end of the club is against the lower neck where the shoulder is almost identical to the applicant's figure 1. As such the Examiner believes it is very appropriate to use the reference of Sosin due to the figures. The argument that in claim 13 the statement "...and the golf putter grip dimension D4, proximal the apparatus first end (20), being greater than the grip clip second end dimension D2" is not indefinite is disagreed with. The golf putter grip is not proximal (near) the apparatus first end (20) but far away.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Blau whose telephone number is (571) 272-4406. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLB/ 23 March 2006



STEPHEN BLAU
PRIMARY EXAMINER